

REMARKS

Status of the Claims and Amendments thereto

Claims 1-32 are cancelled without prejudice or disclaimer of the subject matter contained therein. Claims 53-60 are added. Claims 45-48 are also cancelled and reintroduced as claims 53-55. The phrase added to the end of claim 33 is virtually the same phrase previously presented to the end of claim 49 in the prior amendment. In the claims, the phrase "preventing" is deleted and the description of the subject matter to which the active ingredient is administered is clarified. Claim 39 has been amended to include an active step as in, for instance, claim 50. The claims dependent from claim 45 and 48 have been amended or added so that they are dependent on claims 53 and 60, respectively. The basis for claim 53 is page 36, lines 10-11.

Claim Objections

Claims 29-32, 45 and 46 are objected to as being substantial duplicates of claim 28 for the reasons set forth in the last full paragraph on page 2 through the first full paragraph on page 3 of the Office Action. The objection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Basically, the Examiner's position is that the intended use does not serve to distinguish the claims. However, the intended use in the claims affected the effective amount of the active

ingredient present in each claim. Thus, the claims were not duplicative.

The Examiner should further note that claim 28 has been cancelled in favor of claim 45 (now claim 53). To clarify the record, the intended use in claim 45 modified the "effective amount" language of the claim and thus helped to limit the amount of the effective ingredient present in the claim, in contrast to claim 28. Moreover, the remaining claims that were dependent on claim 28 are amended so that they are dependent on claim 53. Thus, this rejection is moot in view of the cancellation of the alleged duplicate claims.

Obviousness-Type Double Patenting Rejections

Claims 28-32 and 45-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of copending Application No. 10/148,486 (US 2002/0039670) for the reasons in the last paragraph on page 3 through page 4 of the Office Action.

Applicant is considering the filing of a Terminal Disclaimer at the appropriate time. A terminal disclaimer may be filed in whichever copending application faces the situation where the provisional rejection ripens into a non-provisional rejection. Otherwise, the premature filing of a terminal disclaimer is an unnecessary expenditure of funds.

Since this is a provisional rejection, the Examiner should comply with MPEP 804, right column, first full paragraph, 800-

19, section B of the MPEP (revised February 2003) and hold these rejections in abeyance until one of the applications is allowed in accordance with PTO procedures. The Examiner's comments on page 4 of the Office Action with respect to MPEP 804 are incorrect. The relevant portion of the above-quoted MPEP is attached for the Examiner's convenience.

Moreover, since prosecution is pending in these applications the filing of a terminal disclaimer is entirely premature at this point since amendments may render the rejection moot. Accordingly, the Examiner is respectfully requested to comply with MPEP 804 at page 800-19.

Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 33-44 are rejected by the Examiner under 35 U.S.C. 112, second paragraph, for the reasons set forth in the last two paragraphs on page 5 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

In claim 33, the subject matter to which the active ingredient is administered is clarified. In claim 39, the active step of the claimed method is clarified. Thus, this rejection is moot and should be withdrawn by the Examiner.

Rejection of Claims 1-13, 15, 17-19 Under 35 U.S.C. 102(e) Over Umeda et al.

Claims 28-52 are rejected by the Examiner under 35 U.S.C. 102(e) over Umeda et al. for the reasons set forth on page 5, third paragraph, through the first two lines on page 7 of the Office Action. There are two (2) separate issues. The first issue relates to the patentability of the composition claims. The second issue relates to the patentability of the method of use claims. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner should note that the "preventative" aspect of the invention has been deleted from all claims. Also, the cosmetic compositions of the invention are limited to percutaneous compositions, that is, compositions limited to percutaneous applications.

Accordingly, the present invention, as amended, is readily distinguishable from the teachings of the Umeda et al. patent. Thus, the rejection of claims 33-44 and 49-60 under 35 U.S.C. 102(e) Over Umeda et al. should be withdrawn by the Examiner.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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